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EXAMINER	
PANDYA, SUNIT	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/805,243	ECK ET AL.	
	Examiner	Art Unit	
	Sunit Pandya	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *17-29,46,54-63 and 65-67* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17-29,46,54-63 and 65-67* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The Examiner has considered the Information Disclosure Statements (IDS) submitted on March 31, 2004 and January 13, 2005.

Election/Restrictions

2. Applicant's election without traverse of claims 17-29 and 31-46 and the addition of new claims 50-69 in the reply filed on November 1, 2004 is acknowledged.

Response to Amendment

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action, dated 3/29/2006, is withdrawn.

Double Patenting

4. Claims 17-29, 46 and 54-67 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim1-44 of copending Application No. 09/659738. Although the conflicting claims are not identical, they are not patentably distinct from each other because, although the conflicting claims are not identical, they are not patentably distinct from each other because at least claim 10 of the patent anticipates at least application claims 17 and 29. Accordingly, application claims 17 and 29 are not patentably distinct from patent claim 10. Patent claim 10 requires "pager circuitry" incorporated in a "pager cartridge", "a user interface", "a

display", "a processing system" and "the pager cartridge further comprising a memory for storing a video game program and said processing system being operable in response to user inputs to execute the video game program stored in the memory of said pager cartridge" while application claims 17 and 29, respectively, only require "radio circuitry", "a user interface", "a memory ", and "a processing system". Thus it is apparent that the more specific patent claim 10 is encompassed by application claims 17 and 29, respectively. Following the rationale in In re Goodman cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 46 56, 57, 60 and 62, 64, 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darling et al. (WO 93/23125) and further in view of Hilgendorf et al. (US Patent 5,249,800).

Regarding claim 46, Darling et al. disclose a hand-held game machine (10) that comprises a display (15), radio frequency communication circuitry (communications unit 30) for transmitting and receiving messages over a wireless communication network (Figure 1 along with the related description thereof), and a processing system (processing unit 31 and CPU 11) for executing a video game program, however Darling et al. fails to teach of the processing system in responsive to a received message for disabling the communication circuitry.

Hilgendorf et al. teach of the processing system responsive to a received message for disabling the communication circuitry (col. 4, lines 40-63, col. 6-7, lines 61-3) wherein Hilgendorf teaches of transmitting a disable signal over a line in response to a fault detection. It would have been obvious for one skilled in the art at the time of the invention to have implement the disabling system into the gaming system provided by Darling et al. to allow the network controller to control the game play and players

Darling et al. teach that the game-activation data comprises collectible activation data for activating additional "skills, possessions, etc." throughout game play in a "Dungeon and Dragons" type environment (page 9, lines 14-18 and page 10, lines 1-6). However, Darling et al. does not explicitly teach that the game-activation data activates additional video game characters as recited in claim 33 or that the game-activation data activates additional video game levels as recited in claim 35. It is notoriously well known in the gaming art for a video game program to activate or "unlock" additional game features, characters and levels in order increase game excitement for players of the game. It would have been obvious for one skilled in the art at the time of the

invention to activate additional game characters or game levels, based on the teachings of Darling et al. to activate additional "skills, possessions, etc.," in order to increase excitement for players of the game machine of Darling et al.

Regarding claim 56, Darling et al. teach that the messages are transmitted along with a persona character (page 9, lines 24-30, wherein a message "has killed the dragon" indicating a player accomplishment is transmitted with a persona character "David D." indicating the player who achieved the accomplishment).

Regarding claims 57 and 60, Darling et al. teach that the messages comprise user-defined graphics (page 9, lines 21-27, wherein messages are comprised of keyboard input defined by a user and wherein any string of at least two characters would constitute a graphic, the players could also select message from a menu as a predefined message from the memory).

Regarding claims 62, 64 and 65, Darling et al. teach a storage device (memory 22) for storing predefined messages for composing messages and input device (14) for generating user-defined messages (page 9, lines 19-33). However, Darling et al. does not explicitly teach a storage device for storing user-defined messages (words, phrases, graphics, symbols and audio pieces) for composing messages as recited in claims 62, 64 and 65. It would have been obvious matter of design choice to modify Darling et al. to store user-defined messages for composing messages in memory 22 along with predefined messages, since applicant has not disclosed that storing user-defined messages solves any stated problem or is for any particular purpose and it appears that

the memory 22 in the game machine 10 of Darling et al. would perform equally well storing both predefined messages and user-defined messages.

7. Claims 17-26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darling et al. in view of Marrs (U.S. Patent No. 5,376,931).

Darling et al. teach a game machine (10) as recited in independent claims 17 and 29. The disclosed gaming machine (10) comprises radio circuitry configured to transmit and receive messages via a wireless communication system (communications unit 30), specifically a paging system (Figure 1 along with the related description thereof). The game machine (10) includes a user interface (inputs 14) enabling a user to provide inputs thereto and a processing system (processing unit 31) operable in response to the user inputs (inputs 14) to transmit messages via the wireless communication system or paging system (page 9, lines 19-33). However, Darling et al. does not explicitly teach a memory for storing message credits, wherein the processing system (processing unit 31) transmits messages via the wireless communication system or paging system (communications unit 30) if sufficient message credits are stored in the memory. In a related messaging apparatus, Marrs teach a debit message authorization system for radio receivers (Figure 1 along with the related description thereof and Abstract) in which a receiver (56) receives message information and a memory (104, 106) stores message the received message information for presentation to a user. The radio receiver (56) includes a debit meter (72) that indicates a number of available credit units for enabling the presentation of the stored message information (col. 3, lines 51-59 and

Abstract). The debit meter allows users to reduce messaging costs by paying for the required bandwidth needed to receive messages instead of incurring monthly charges for the same service (col. 4, line 56 to col. 5, line 6). It would have been obvious for one skilled in the art at the time of the invention to incorporate the debit meter (72) as taught by Marrs in to the game machine (10) as taught by Darling et al. in order to reduce the required bandwidth for messaging, which allows users to pay for messages received instead of incurring monthly charges for the same service.

Regarding claim 18, the combination of Darling et al. and Marrs teaches that the radio circuitry is provided as part of a pager cartridge that is removably attachable to the game machine (page 8, lines 7-15 of Darling).

Regarding claim 19, Marrs teaches that the debit meter (72) assesses a per character charge for messages (at block 512 of Figure 3, along with the description at col. 3, lines 59-66 and col. 5, lines 7-13), which changes the number of messaging credits in accordance with sizes of a transmitted message. Therefore, the combination of Darling et al. and Marrs would teach that the processing system (31) of Darling decreases the number of message credits in memory in accordance with sizes of the transmitted message as taught by Marrs.

Regarding claim 20, Marrs teaches that the number of message credits in the memory (104, 106) is increasable in response to user inputs, wherein a user pays necessary fees to retrieve a stored message (col. 5, lines 28-39). Therefore, the combination of Darling et al. and Marrs teaches that the number of message credits in the memory would be increasable in response to user inputs via the user interface (14).

Regarding claim 21, the combination of Darling et al. and Marrs teaches that the user inputs (14) comprise alphanumeric inputs (page 9, lines 19-33 of Darling).

Regarding claim 22, the combination of Darling et al. and Marrs teaches that the credit replenish message of Marrs is transmitted to a remote location for authentication of inputs and the number of message credits in the memory is increased only if an authentication message is received by the radio circuitry from the remote location (col. 5, lines 28-38 of Marrs)

Regarding claim 23, the combination of Darling et al. and Marrs teaches a display (display 15 of Darling and display 68 of Marrs), wherein the processing system is operable to cause the display to display indicia indicative of the number of message credits in the memory (col. 2, lines 47-55 of Marrs, wherein the debit meter 72 shows the number of message credits in the memory on display 68).

Regarding claim 24, the combination of Darling et al. and Marrs teaches a display (display 15 of Darling and display 68 of Marrs), wherein the processing system is operable to cause the display to display reminder indicia when the number of message credits in the memory falls below a predetermined number of message credits (col. 5, lines 28-39 of Marrs).

Regarding claim 25, the combination of Darling et al. and Marrs teaches that the processing system is operable in response to user inputs to cause the display-to-display messages received by the radio circuitry (col. 5, lines 20-27 of Marrs).

Regarding claim 26, the combination of Darling et al. and Marrs teaches that the processing system is operable to change the number of message units stored in the

memory in response to a message received by the radio circuitry (blocks 506, 520 of Figure 3 along with the related descriptions thereof and col. 4, lines 46-50 of Marrs).

8. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darling et al. and Marrs, as applied to claim 17 above, and further in view of Taskett et al. (U.S. Patent No. 6, 044,247).

The combination of Darling et al. and Marrs teaches that the processing system is operable to change the number of message units stored in the memory in response to a message received by the radio circuitry (blocks 506, 520 of Figure 3 along with the related descriptions thereof and col. 4, lines 46-50 of Marrs). However, the combination of Darling et al. and Marrs does not explicitly teach that the number of message units stored in the memory is changed in accordance with scanned data as recited in claim 27 or is changed in accordance with data read from a magnetic stripe as recited in claim 28. In a related messaging system, Taskett et al. teach a paging credit and debit system that includes a paging card (300) to replenish a pager account balance via an authorization code (304) stored in a bar code, magnetic code or other suitable indicia on the card (Figure 3 along with the related description thereof). The paging card (300) allows users to replenish their pager account balance to access paging services without manual input, which eases operation of the paging system and reduces user error when entering the authorization code 304 (col. 5, lines 55-57). It would have been obvious to incorporate the paging card (300) and authorization code (304) as taught Taskett et al. into the game machine as taught by the combination of Darling et al. and Marrs in order

to reduce manual input when replenishing pager credits, which eases operation of the paging system and reduces user error as taught by Taskett et al. in col. 5, lines 55-57.

9. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darling et al. view of Hilgendorf et al. (US Patent 5,249,800) and further in view of Wagner et al., "Human Factors Design Guide: For Acquisition of Commercial-Off-The-Shelf Subsystems, Non-Developmental Items, and Developmental Systems" which was published on January 15, 1996 (hereafter "Wagner et al.").

Darling et al. disclose a hand-held game machine (10) that comprises a display (15), radio frequency communication circuitry (communications unit 30) for transmitting and receiving messages over a wireless communication network (Figure 1 along with the related description thereof), and a processing system (processing unit 31 and CPU 11) for executing a video game program, however Darling et al. fails to teach of the processing system in responsive to a received message for disabling the communication circuitry. Hilgendorf et al. teach of the processing system responsive to a received message for disabling the communication circuitry (col. 4, lines 40-63, col. 6-7, lines 61-3) wherein Hilgendorf teaches of transmitting a disable signal over a line in response to a faulty detection. It would have been obvious for one skilled in the art at the time of the invention to have implement the disabling system into the gaming system provided by Darling et al. to allow the network controller to control the game play and players. Darling et al. also teaches a game machine comprising a liquid crystal display

(15) for displaying game displays (Figure 1 along with the related description thereof), but Darling et al. do not explicitly teach a touch-sensitive display as recited in claim 54.

In a related display application, Wagner et al. teaches that touch panels or screens should be used to provide an overlaying control function to a display device if direct visual reference access and optimum direct control access are desired (section 8.8.4.2 on page 8-147). Such touch panels or screens provide users with the ability to input data (such as messages during game play as taught by Darling) quickly as shown in Exhibit 8.8 on page 8-138. Therefore, it would have been obvious for one skilled in the art at the time of the invention to incorporate a touch panel or screen as taught by Wagner et al. into the game machine of Darling et al. and Hilgendorf et al. in order to allow players to enter data (message information) quickly during game play while offering direct visual reference and direct control access to the players as taught by Wagner in section 8.8.4.2 on page 8-147.

10. Claims 55, 58, 59, 61, 63, 66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darling et al. in view of Wagner et al., and further in view of Marrs.

Regarding claim 55, the combination of Darling et al. and Wagner et al. teach a game machine (10) that comprises a touch-sensitive display (pages 8-138 and 8-147 of Wagner et al.), wireless communication circuitry (30) for transmitting and receiving messages, a processing system (31) for executing a video game program that generates game displays on the display and one or more input devices (14) supplied

with inputs for instructing movement of a game character during execution of the video game program (Figure 1 along with the related description thereof in Darling et al). Darling et al. teach a storage device (memory 22) for storing predefined messages for composing messages and input device (14) for generating user-defined messages (page 9, lines 19-33). However, Darling et al. does not explicitly teach a storage device for storing user-defined messages (words, phrases, graphics, symbols and audio pieces) for composing messages as recited in claims 62 and 65. It would have been obvious matter of design choice to modify Darling et al. to store user-defined messages for composing messages in memory 22 along with predefined messages, since applicant has not disclosed that storing user-defined messages solves any stated problem or is for any particular purpose and it appears that the memory 22 in the game machine 10 of Darling et al. would perform equally well storing both predefined messages and user-defined messages. The combination of Darling et al. and Wagner et al. does not explicitly teach a vibration circuit for generating vibrations when messages are received. In a related messaging application, Marrs teaches a messaging system as discussed above that includes a tactile alerting device 60 (a vibration circuit) to produce a vibrating alert when messages are received in order to alert the user that a message was received (col. 2, lines 40-46 of Marrs). Therefore, it would have been obvious for one skilled in the art at the time of the invention to incorporate a tactile alerting device 60 as taught by Marrs into the game machine of Darling et al. in order to alert players that a message was received as taught by Marrs in col. 2, lines 40-46.

Regarding claims 58 and 59, Marrs teaches an audible alerting device 58 that generates sounds (or music) when messages are received (col. 2, lines 40-46).

Regarding claims 61 and 63, Darling et al. teach predefined messages that can be selected, from memory (storage), for composing messages to game players from a menu (page 9, lines 19-24).

Regarding claim 66, Darling et al. teaches an on-screen keyboard for composing messages (page 9, lines 19-24).

Regarding claim 67, Marrs teaches selectively stores received messages (blocks 504 and 514 of Figure 5 along with the related description thereof).

Response to Arguments

11. Applicant's arguments filed 2/24/2005 have been fully considered but they are not persuasive.

The applicant argues that neither Darling et al. nor Marrs disclose or teach of transmitting messages only if sufficient message credits are stored in a memory. The examiner respectfully disagrees with the applicant, Marrs teaches a debiting unit that enables access to the stored message when there is sufficient number of available credits units in the debit meter and disables access to the message when the debit meter is depleted (col. 3-4, lines 66-23). It would have been obvious to one in ordinary skill to modify Marrs to enable access to transmit message only if sufficient number of credits are available in the debit meter and disable access to transmit message when

the debit meter is depleted, similar to received message options, thus allowing user to pay per individual messages rather than pay monthly charges.

Regarding claim 46, the applicant argues that Darling et al. does not disclose all the claim limitations especially processing system in responsive to a received message from disabling the circuitry, the examiner notes the argument but respectfully disagrees with the applicant. Darling et al. disclose a hand-held game machine (10) that comprises a display (15), radio frequency communication circuitry (communications unit 30) for transmitting and receiving messages over a wireless communication network (Figure 1 along with the related description thereof). Regarding the executing a video game program wherein the processing system is responsive to a received message for disabling the communications, it is well known in the art, to allow the communications between the gaming machine to be disabled in response to a received message. However Hilgendorf et al., as disclosed in the rejection above, also teaches of the processing system responsive to a received message for disabling the communication circuitry (col. 4, lines 40-63, col. 6-7, lines 61-3) wherein Hilgendorf teaches of transmitting a disable signal over a line in response to a fault detection. It would have been obvious for one skilled in the art at the time of the invention to have implement the disabling system into the gaming system provided by Darling et al. to allow the network controller to control the game play and players.

The applicant argues that combination of Darling et al. and Marrs et al. does not teach or disclose transmitting message only if sufficient credits are stored in a memory. The examiner respectfully disagrees with the applicant. The combination of Darling et

al. and Marrs et al. teaches a debit message authorization system (Figure 1 along with the related description thereof and Abstract) in which a receiver (56) receives message information and a memory (104, 106) stores the received message information for presentation to a user. The radio receiver (56) includes a debit meter (72) that indicates a number of available credit units for enabling the presentation of the stored message information (col. 3, lines 51-59 and Abstract). The controller enables access to the stored message with there is sufficient number of credits available and disable the access with insufficient credits (col. 4, lines 1-23).

Regarding the claims 27 and 28, the applicant argues that the combination of prior art of Darling, Marrs and Taskett does not teach of all the claim limitations. The examiner respectfully disagrees with the applicant, the combination of Darling et al. and Marrs teaches that the processing system is operable to change the number of message units stored in the memory in response to a message received by the radio circuitry (blocks 506, 520 of Figure 3 along with the related descriptions thereof and col. 4, lines 24-50 of Marrs). However, the combination of Darling et al. and Marrs does not explicitly teach that the number of message units stored in the memory is changed in accordance with scanned data as recited in claim 27 or is changed in accordance with data read from a magnetic stripe as recited in claim 28. In a related messaging system, Taskett et al. teach a paging credit and debit system that includes a paging card (300) to replenish a pager account balance via an authorization code (304) stored in a bar code, magnetic code or other suitable indicia on the card (Figure 3 along with the related description thereof).

The applicant argues that claim 55 calls for a storage for storing user-defined graphics and symbols for composing messages, is not taught or disclosed by any single reference of combination thereof. The examiner respectfully disagrees with the applicant. The reference of Marrs teaches of a storage device for storing user-defined graphics and symbols (col. 3, lines 20-43, and col. 3-4, lines 51-23).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunit Pandya whose telephone number is (571) 272-2823. The examiner can normally be reached on M - F: 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert OLSZEWSKI can be reached on (571) 272-6788. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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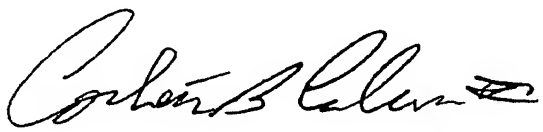

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